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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/712,667	11/13/2003	Donald Ervin Steinwandt	THOLAM P215US	2606

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DAVIS & BUJOLD, P.L.L.C.  
FOURTH FLOOR  
500 N. COMMERCIAL STREET  
MANCHESTER, NH 03101-1151

EXAMINER
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PARKER, FREDERICK JOHN

ART UNIT	PAPER NUMBER
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1762

DATE MAILED: 06/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/712,667

Applicant(s)

STEINWANDT ET AL.

Examiner

Frederick J. Parker

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 April 2005.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-3 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☒ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_

- 4) ☒ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. 6/1/05  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Arguments***

#### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1-3 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The reasons are the same as in the previous Action.

The Examiner has fully considered the Declaration of Dr Payzant of 4/13/05.

In the 1<sup>st</sup> paragraph of page 2, it is inferred that use of caulk by “a wide cross-section of education groups” would include chemists/ experts. This is not persuasive given the criteria for determining the level of ordinary skill of MPEP 2141.03 which excludes experts. These criteria were those used by the Examiner in formulating the enablement rejection being maintained.

In the second paragraph, Dr. Payzant states “most individuals involved in the manufacture of chemical compositions would know what cationic surfactant means” and notes the surfactants “are readily available from many industrial chemical suppliers”. Again, the level of ordinary skill is not of chemists and chemical manufacturers, and further one of ordinary skill as determined by the Examiner previously would not have access to industrial chemical suppliers. The Examiner

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also points out the claims are METHOD claims, not composition, so the arguments are not germane.

In the third paragraph of page 2, Dr. Payzant states he “is not aware of any cationic surfactant that would be unsuitable in the method” but fails to provide evidence of how many, which, and what types of cationic surfactants he tried to reach this opinion. Moreover, a contradiction is made by the assertion that “a number of (useful) cationic surfactants” are “readily available in a few conventional household cleaners” (emphasis added). The Examiner asserts that the statement that “a few” common cleaners are suitable attests to undue burden of experimentation required by one of ordinary skill given the huge number of cleaners available today. Furthermore, the question remains if one of ordinary skill would recognize the cationic surfactant in such cleaners. In fairness to Applicants, the Examiner looked at all the household cleaners he could find in his residence (15). As tabulated below, none of those listing ingredients (7) were identified to contain “cationic surfactants”.

TABLE 1 : HOUSEHOLD CLEANERS AT EXAMINER’S RESIDENCE (6/1/05)\*

<u>Cleaner (with formulations listed)</u>	<u>Cationic Surfactant listed?</u>
Lysol Kitchen Cleaner	NO
Dow Multi-Purpose Cleaner	NO
Windex	NO
ALL Detergent	“anionic and nonionic surfactant”
Clorox OXIMAJIC	“surfactants” (not specified)
Soft-soap liquid soap	NO
Armstrong Floor Cleaner	“surfactants” (not specified)

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\*Examiner will submit as Declaration if Appeal is submitted.

Thus these arguments are not persuasive.

Dr. Payzant's comments regarding strength of the surfactants might be persuasive if the Examiner knew the types of surfactants used. Clearly concentrations are limited if household cleaners are used since increasing concentration of commercially produced formulations would not be within the purview of one skilled in the art as defined previously.

In addition to the Declaration, the Examiner addresses Applicants' Remarks which are not the same as those of the Declaration, the responses above incorporated herein.

The explanation on page 4 including allowing the caulk dry for 4 hours is not commensurate in scope with claims 1-2.

Arguments relative to manufactured kits are not commensurate with scope of claims which are METHOD claims. Applicants argue that organic chemists or kit manufacturers- i.e. experts- would be users, but again they do not qualify as "one of ordinary skill". The case law of 70 USPQ 32 is not germane because it precedes the requirements for determining the level of ordinary skill now used in patent law.

Applicants arguments that the Examiner believes the surfactant is a reactant is simply erroneous; to the contrary the Examiner believes neither it nor the formulation containing it can react detrimentally with caulk. Since household cleaners often contain ammonia, caustic, etc, this issue is quite pertinent to the rejection at hand and the issue of undue experimentation.

Finally the Examiner points out a critical passage on page 6, 11-14 of Remarks wherein it is stated that household materials may "contain a suitable cationic surfactant", in complete contradiction to lines 7-9 that asserts there are no known unsuitable cationic surfactants. The

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term "suitable" recognizes there are also "unsuitable" cationic surfactants, supporting one of the Examiner's positions, namely that undue experimentation is required because there are suitable AND unsuitable cationic surfactants.

The rejection of claim 1 is accordingly maintained, and new claims 2-3 are also rejected under 35 USC 1<sup>st</sup> since they employ the same inventive concept under rejection.

3. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frederick J. Parker whose telephone number is 571/ 272-1426. The examiner can normally be reached on Mon-Thur. 6:15am -3:45pm, and alternate Fridays.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy Meeks can be reached on 571/272-1423. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Frederick J. Parker  
Primary Examiner  
Art Unit 1762

fjp